

Appl. No. : 10/665,174
Filed : September 17, 2003

REMARKS

By way of summary, Claims 39–56 were pending in this application and were rejected in the most recent Office Action. By this Amendment, Claims 57–65 have been added and are presented for consideration. Accordingly, Claims 39–65 are now pending in this application.

Rejections based on Schwartz

Claims 39–44, 46–53, 55, and 56 were rejected in the Office Action as being anticipated by U.S. Patent No. 5,513,652 to Schwartz. Dependent Claims 45 and 54 were also rejected as being obvious in view of Schwartz. Applicants respectfully submit that independent Claims 39 and 49 are not anticipated by Schwartz because the cited reference fails to teach or suggest all the limitations of Claims 39 and 49.

The Schwartz Reference

In explaining the rejection under § 102, the Office Action stated that “Schwartz teaches a constriction sleeve for constricting boy [sic] tissue when applied thereto, the sleeve comprising . . . at least one suture aperture; a reinforcement structure; wherein the reinforcement structure is positioned proximate the suture aperture” Schwartz discloses devices and methods for facilitating penis erectile function that operate to exert external pressures applied to “selected portions [of the penis] so as to not impede arterial blood flow to the penis but impede venous blood flow from the penis and thereby establish and maintain the penis in an erectile position.” Abstract of the Schwartz Patent. The Schwartz device includes a liquid retaining chamber 32 that includes one-way valves on an interior wall of the chamber, see Figure 14. The one-way valves include “an orifice 38 surrounded by an area of elastomeric material 40, such as latex or the like, which constricts orifice 38 to prevent passage of medication or the like from liquid retaining chamber 32 into condom 2.” Col. 6:48–51. When pressure is applied to the chamber, the “orifice 38 is urged open and the medication or the like flows into condom 2 and onto the penis.” Col. 6:54–55.

Claims 39–56

As depicted in Figure 14, the one-way valves extend only through an interior wall of the chamber. The exterior wall of the chamber (that labeled as “reinforcement structure” in the Office Action) is a solid wall that does not include valves, or any portion of a valve, extending

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therethrough. In contrast, independent Claim 49 recites, in part, "said device comprising at least one suture aperture extending through the device and a reinforcement structure." Schwartz does not teach or suggest an aperture extending through both the device and a reinforcement structure. The one-way valves extend only through an interior wall of the chamber and do not extend through any part of the exterior wall of the chamber (the wall labeled "reinforcement structure" in the Office Action). Accordingly, Applicants respectfully submit that Schwartz does not anticipate Claim 49. Additionally, Claims 50-56 depend from Claim 49 and are patentable for the same reasons set forth above with respect to Claim 49 in addition to the patentable subject matter contained therein. Thus, Applicants respectfully request the withdrawal of the rejections of Claims 49-56.

Applicants also respectfully submit that Claim 39 is not anticipated by Schwartz. First, Claim 39 recites, in part, "said sleeve further comprising at least one suture aperture extending through the sleeve." Schwartz discloses one-way valves extending through only the interior wall of the chamber. The valves of Schwartz do not extend *through* the sleeve; the valves extend only through the interior wall of the chamber located within the sleeve and do not extend through any portion of the sleeve. Thus, Applicants respectfully submit that this limitation is not met.

Second, Claim 39 further recites, in part, "said sleeve further comprising a reinforcement structure." While the Office Action asserts that the exterior wall of the chamber is a reinforcement structure, there is no reference, no teaching, and no suggestion in Schwartz that the exterior wall of the chamber constitutes a reinforcement structure or what the exterior wall would supposedly be reinforcing. The exterior wall is the same width as the wall of the other parts of the device, and would consequently not provide any more reinforcement than any other part of the device. Thus, the wall is not a reinforcement structure and the Office Action provides no evidence that the exterior wall reinforces. Moreover, a brief glance at Figure 14 (that is used to identify the "reinforcement structure" in the Office Action) reveals that there is nothing that the exterior wall of the chamber would be reinforcing. Indeed, there is no teaching or suggestion in Schwartz that the exterior wall of the chamber is a reinforcement structure. Furthermore, the exterior wall is configured to collapse upon the application of external pressure to discharge the fluid contained in the chamber. Thus, the exterior wall's operation is inconsistent with its being construed as a reinforcement structure of the sleeve.

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Applicants respectfully submit that Schwartz does not anticipate Claim 39 at least for the reasons set forth above and that Claim 39 is patentable over the Schwartz reference. Additionally, Claims 40–48 depend from Claim 39 and are patentable for the same reasons set forth above with respect to Claim 39 in addition to the patentable subject matter contained in each of the dependent claims. Accordingly, Applicants respectfully request the rejections of Claim 39–48 be withdrawn.

New Claims 57–65

New independent Claim 57 recites, in part, “said sleeve further comprising a reinforcement structure and a suture aperture extending through the sleeve and at least a portion of the reinforcement structure for affixing said sleeve to the body tissue when said sleeve is in its desired position.” Additionally, new independent Claim 62 recites, in part, “said device comprising at least one suture aperture extending through the tubular portion and a reinforcement structure.” Even if the exterior wall of the Schwartz chamber were construed as a reinforcement structure and the one-way valves were construed as suture apertures, which construction Applicants maintain is improper, Claims 57 and 62 do not read on Schwartz at least because Schwartz does not teach or suggest a suture aperture extending through a portion of the reinforcement structure as well as the sleeve or tubular portion. The one-way valves disclosed in Schwartz extend only through the internal wall of the chamber, which does not form part of the sleeve or tubular portion.

Furthermore, it would not have been obvious to modify Schwartz to include a one-way valve through any portion of the exterior wall because doing so would contradict the function of the chamber as described in the specification. As previously stated, when the fluid flows from the chamber, it “flows *into* condom 2 and *onto* the penis.” Col. 6:54–55. Additionally, if such a reconstruction of Schwartz was obvious, the disclosure of Schwartz would have suggested or alluded to such an alternative embodiment. However, there is no disclosure in Schwartz that teaches or suggests such a modification of the structure or operation of the device.

Thus, Applicants respectfully submit that new independent Claims 57 and 62 are patentable over Schwartz and respectfully request allowance of the same. Additionally, Claims 58–61 and 63–65 depend from Claims 57 and 62 and are patentable for the same reasons set forth above with respect to Claims 57 and 62 and for the additional patentable subject matter

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contained in the dependent claims. Accordingly, Applicants respectfully request allowance of new Claims 57-65.

CONCLUSION

Based on the foregoing, Applicants believe that Claims 39-65 are each in condition for immediate allowance and respectfully request the same. Applicants have endeavored to respond to each issue raised by the Examiner. However, if there remain any unresolved issues that could be resolved via a telephone conference, Applicants invite the Examiner to initiate the same with Applicants' representative at the telephone number shown below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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